

## REMARKS

### I. PRELIMINARY REMARKS

Claims 1, 6-11, 13, 15, 17, 18, 20 and 25 have been amended. No claims have been added or canceled. Claims 1-25 remain in the application. Reexamination and reconsideration of the application are respectfully requested.

Applicant notes that the amendments above merely change the phrase “adapted to” to the phrase “configured to.” Applicant respectfully submits that the amendments should be entered for purposes of appeal because the “adapted to” issue is merely a matter of form and was not raised until the Final Office Action, which was the **fourth** Office Action on the merits. See 37 C.F.R. § 1.104(b) (“*Completeness of examiner's action*. The examiner's action will be complete as to all matters ...”) and MPEP § 707.07(g) (“piecemeal examination should be avoided as much as possible”).

### II. OBJECTION TO THE DECLARATION

The declaration has been objected to. The objection appears to be under 37 C.F.R. § 1.63, and the basis for the objection appears to be that the exact language found in 37 C.F.R. § 1.63(b)(3) was not used. It is the understanding of applicant's undersigned representative that there is now a moratorium on this type of formalistic objection to the declaration and, for that reason alone, the objection should be withdrawn. To the extent that applicant's undersigned representative is incorrect about the moratorium, the objection is respectfully traversed.

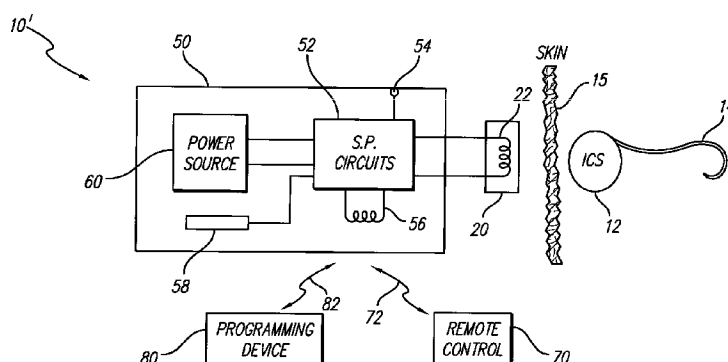
37 C.F.R. § 1.63(b)(3) indicates that the oath or declaration must “[s]tate that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.” The declaration in the present application states that the inventors “acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.” In other words, the objection is based on the fact that current declaration recites “all information which is material” instead of “all information known to the person to be

material.” Applicant respectfully submits that this minor difference is moot because the statement at issue in the present declaration makes reference to 37 C.F.R. § 1.56, and 37 C.F.R. § 1.56 describes the “duty to disclose to the Office ***all information known to that individual*** to be material to patentability as defined in this section.” 37 C.F.R. § 1.56(a), emphasis added. In other words, by making reference to 37 C.F.R. § 1.56, the declaration clarifies that that “all information which is material” is, in fact, information which is known to the declarant to be material. The objection should, therefore, be withdrawn.

### III. BRIEF DESCRIPTION OF AN EXEMPLARY EMBODIMENT

The present inventions, as defined by the claims, are directed generally to sound processors and to cochlear implant systems that include sound processors. Referring to Figure 3, which is reproduced below, a cochlear implant system 10' in accordance with one exemplary embodiment includes an implantable stimulator 12 and an **external** sound processor 50. The external sound processor 50 includes a coil 22 for transferring stimulation signals and power signals to the implantable stimulator 12. A power source 60 is **permanently integrated into** the external sound processor 50. To that end, in

those instances where the permanently integrated power source 60 is rechargeable, the sound processor 50 may be provided with a coil 56 that receives power from an external charging source and recharges the power source. Alternatively, as illustrated in Figure 6, the



### Figure 3 of the Present Application

permanently integrated power source 60 may receive recharging power by way of electrical contacts 61 and 62 that are carried on the surface or, or embedded within, the sound processor case.

There are a number of advantages associated with such sound processors and cochlear implant systems. For example, because the power source is permanently integrated into the present sound processor, the user does not have to carry and/or replace small sound processor batteries, as is the case with conventional sound processors. The present sound processors will also typically be smaller and have fewer components (i.e. no door, latch and/or electrical connectors for a removable battery) than sound processors with removable batteries. [See, e.g., paragraphs 0012-0016 of the present application.]

#### **IV. PRIOR ART REJECTIONS**

##### **A. The Rejections**

Claims 1-4, 6, 7, 21 and 25 have been rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,272,382 to Faltys (“the Faltys patent”). Claims 5 and 8 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Faltys patent and U.S. Pat. Pub. No. 2002/0076071 naming Single (“the Single publication”). Claims 9-13, 15, 17-20 and 22-24 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Faltys patent and U.S. Patent No. 4,918,736 to Bordewijk (“the Bordewijk patent”). Claim 14 has been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Faltys patent, the Bordewijk patent and the Single publication. Claim 16 has been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Faltys patent, the Bordewijk patent and U.S. Patent No. 3,942,535 to Schulman (“the Schulman patent”).

The rejections under 35 U.S.C. § 103 are respectfully traversed to the extent that they are applicable to the claims as amended above. Reconsideration thereof is respectfully requested.

## B. Discussion Concerning Claims 1-8

Independent claim 1 is directed to a sound processor for use with an implantable cochlear stimulator. The claimed sound processor comprises a combination of elements including, *inter alia*, “a headpiece ... configured to transfer the stimulation signal and the power signal from the sound processing circuit to the implantable cochlear stimulator” and “a power source ***permanently integrated into*** the sound processor and configured to provide operating power for the sound processing circuit and implantable cochlear stimulator.” The respective combinations defined by claims 2-8 include, *inter alia*, the elements recited in claim 1.

The Faltys patent fails to teach or suggest the claimed combinations. For example, the Final Office Action appears to have taken the position that the external speech processor illustrated in Figure 1A and described in column 7, lines 59-67 and column 8, lines 8-10 corresponds to the claimed “sound processor.” [Office Action at pages 2 and 3.] The purported “sound processor” illustrated in Figure 1A includes a speech processor and “a power source (e.g., a replaceable battery)” within a wearable unit 102. [Column 7, lines 60-64.] The Faltys patent also indicates that “the batteries employed within the wearable unit 102 (FIG. 1A) or the BTE unit 120 (FIG. 1B) may be readily replaced when needed.” [Column 9, lines 19-21.] As such, the power source in the speech processor illustrated in Figure 1A simply is not “***permanently integrated into***” the wearable unit 102.

Faced with this clear difference between the invention defined by independent claim 1 and the system illustrated in Figure 1A of the Faltys patent, as well as the lack of a suitable teaching reference or any case law support, the Office Action based the obviousness determination on the following statement:

[A] non-removable battery differs from a replaceable battery only in the fact that it *can* be removed, if so desired. This ***constitutes an intended use*** for the claimed invention. It is to be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. ***The examiner considers the system of Faltys capable of performing the claimed function of being permanently integrated to the sound***

***processor, because a patient may choose not to remove the battery, or to allow a physician, care-provider, or family member to replace it.***

The battery of Faltys is therefore integrated until someone removes it; Faltys' external portion is also capable of being removed in its entirety, in order to replace the battery.

[Office Action at pages 4 and 5.] Applicant respectfully submits that this statement includes a variety of errors related to claim interpretation and fails to make the showing required for an obviousness rejection. It is also unclear whether or not the Final Office Action is actually asserting that claim 1 is anticipated by the Faltys patent, as opposed to being rendered obvious by the Faltys patent.

## **1. Claim interpretation**

With respect to the first error, a claim limitation which states that one element is “permanently integrated” into another element is not a statement of intended use. It is an unequivocal statement of the relationship between the two elements. To wit, claim 1 does not state that the “power source” is “adapted to be permanently integrated into the sound processor.” Nor does the claim state that the “power source” is “permanently integratable into the sound processor.” Nor does the claim state that the “power source” is “**substantially** permanently integrated into the sound processor.” The claim specifically requires a “power source” that is “permanently integrated into the sound processor.”

It should also be noted that statements of “intended use” are typically associated with the preamble. See MPEP § 2111.02-II. To the extent that the Final Office Action was actually attempting to indicate that functional language may not be used to distinguish an apparatus claim from a prior art device that is structurally identical, applicant respectfully submits that “permanently integrated” is, in fact, a structural limitation.

Turning to the second error, the interpretation of “a power source permanently integrated into the sound processor” presented in the Final Office Action appears to be “a power source that may be removed from the sound processor whenever a person

feels like removing it.” Applicant respectfully submits that such an interpretation is utterly unreasonable. As noted in MPEP § 2111:

The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the “broadest reasonable interpretation” standard: The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 70 USPQ2d 1827 (Fed. Cir. 2004).

To that end, “words of the claim must be given their **plain meaning** unless the plain meaning is inconsistent with the specification” and “[o]rdinary, **simple English words** whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, **are construed to mean exactly what they say.**” MPEP § 2111.01, citations omitted, emphasis added.

Turning first to plain meaning, applicant respectfully submits that the plain meaning of “a power source permanently integrated into the sound processor” is a power source that may not be removed from the sound processor under any normal mode of use. In other words, although a person could smash open the claimed sound processor with a hammer and tear the power source therefrom, the claimed “power source” is nevertheless “permanently integrated into the sound processor.” A power source that may be removed and replaced whenever a person feels like it is certainly not, therefore, within the plain meaning of “permanently integrated.”

With respect to the manner in which one of skill in the art who had reviewed the present specification would interpret “a power source permanently integrated into the sound processor,” the Examiner’s attention is directed to the specification at, for example, paragraphs 0010 and 0014-16:

The present invention addresses the above and other needs by providing a cochlear implant sound processor that is powered by a rechargeable battery that is permanently integrated into the sound processor.

\* \* \*

A sound processor having its own integrated power source in accordance with the present invention also advantageously avoids the need to replace small batteries, or adjust small controls on the device, thereby eliminating the need for good manual dexterity in use of the device. As a result, the

device is much more user friendly for the elderly or others who lack good manual dexterity.

\* \* \*

A sound processor having its own integrated power source in accordance with the present invention further eliminates the need for the user to carry spare batteries. Moreover, because no batteries of any kind are needed ... there are no spare or other batteries lying around which could pose a choking hazard for young children.

\* \* \*

Finally, a sound processor having its own integrated power source in accordance with the present invention may be made much smaller and be more reliable than equivalent units that use replaceable batteries. According to the present invention, the extra components needed to support a removable battery -- mechanical latches or doors, connectors, etc.-- may be eliminated, allowing the size of the sound processor to be smaller and removing potential failure mechanisms.

There is simply no reasonable reading of this portion of the specification, or the remainder of the specification, that would lead one of skill in the art to interpret “a power source permanently integrated into the sound processor” to mean “a power source that may be removed and replaced whenever a person feels like it.”

Additionally, attached hereto as Exhibits 1-3 are copies of three Board of Patent Appeals and Interferences (“Board”) decisions that address the “permanently” issue. Applicant stresses that these unpublished decisions **ARE NOT** binding precedent of the Board. Nevertheless, it is worth noting that in all three instances, the Board reversed rejections based on interpretations of the word “permanently” similar to that presented in the Final Office Action. In *Ex Parte Schoessow*, for example, the Board stated:

[W]e do not see that the applied prior art suggests a feed hopper that is permanently affixed in the livestock feeding structure, or wherein at least a portion of one side of the feed hopper is permanently affixed to the hinged portion of one upright framework side so as to rotate therewith, as required in claim 1 on appeal. In our opinion, a combination of the applied prior art would have provided a removable hopper/bin in the feeder of Harton, not a hopper/bin that is permanently affixed in the feeder of Harton. Since all the limitations of claim 1 are not met or rendered obvious by the prior art applied by the examiner, we will not sustain the 35 U.S.C. § 103 rejection of claim 1.

[Opinion at page 8, emphasis in original.]

It should also be noted that the Examiner herself does not appear to put much stock into the “power source that may be removed and replaced whenever a person

feels like it” interpretation. More specifically, if claim 1 covers the external speech processor with removable batteries illustrated in Figure 1A of the Faltys patent,<sup>1</sup> and if the Final Office Action is correct concerning the other aspects of claim 1, it would appear that the proper rejection of claim 1 would have been an anticipation rejection under Section 102. ***Should this be the case, applicant hereby requests that the Examiner clarify her position in a supplemental Office Action.***

## 2. Obviousness

With respect to the legal standard upon which patentability under 35 U.S.C. § 103 is determined, the Board reiterated in the recent precedential *Ex Parte Catan* opinion<sup>2</sup> that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” citing *In re Kahn*, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), emphasis added. To that end, “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected [the] components for combination in the manner claimed.” *In re Kotzab*, 55 USPQ2d at 1317.

The Final Office Action is devoid of any of the articulated reasoning and particular findings required to make a *prima facie* case of obviousness. In the context of the “power source permanently integrated into the sound processor” recited in independent claim 1, the Final Office Action did not provide any reasoning or findings as to why one of skill in the art would have been motivated to modify the replaceable battery aspect of the Faltys wearable unit 102 (or BTE unit 120) so as to arrive at a “permanently integrated” power source.<sup>3</sup> Instead, and as discussed in detail above, the Final Office Action appears to be asserting that the replaceable battery in the Faltys wearable unit 102 is “permanently integrated” into the wearable unit.

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<sup>1</sup> Applicant respectfully submits that it does not.

<sup>2</sup> Appeal 2007-0820.

<sup>3</sup> The Final Office Action did, however, provide reasoning with respect to the “does not include a battery (or power source) removal door” aspect of claims 21, 22 and 24 and this aspect of the Final Office Action is discussed below.



In view of the foregoing, applicant respectfully submits that the Final Office Action failed to establish a *prima facie* case of obviousness as to independent claim 1 and that the rejection of claims 1-4, 6 and 7 under 35 U.S.C. § 103 should be withdrawn.

With respect to claims 5 and 8, applicant respectfully submits that the Single publication, which has been cited for its purported lithium battery teachings, fails to remedy the aforementioned deficiencies in the Faltys patent. Claims 5 and 8 are, therefore, patentable for at least the same reasons as independent claim 1 and the rejection of claims 5 and 8 under 35 U.S.C. § 103 should also be withdrawn.

### C. Discussion Concerning Claims 9-16 and 23

Independent claim 9 is directed to a cochlear implant system that comprises “an implantable portion,” “an external portion” and “a remote control unit.” The **external portion** includes “a headpiece” and “a sound processor [that] comprises sound processing circuits, a coil and a **battery permanently integrated into a closed case.**” The respective combinations defined by claims 10-16 and 23 include, *inter alia*, the elements recited in claim 9.

The cited references fail to teach or suggest the claimed combinations. For example, and as discussed in detail above, the batteries employed in the Faltys wearable unit 102 (Figure 1A) “may be readily **replaced** when needed.” [Column 9, lines 19-21, emphasis added.] To the extent that the Final Office Action has taken a claim interpretation position here similar to that discussed above in the context of independent claim 1, i.e. that “a battery permanently integrated into a closed case” can be reasonably interpreted to mean “a battery that may be removed and replaced whenever a person feels like it,” this aspect of the rejection is traversed for the reasons presented in Section IV-B-1 above. Alternatively, to the extent that the Final Office Action has taken the position that it would have been obvious to modify the Faltys wearable unit 102 (or BTE unit 120) so as to arrive at the claimed invention, applicant respectfully submits that the Final Office Action is devoid of the articulated reasoning and particular findings required to make a *prima facie* case of obviousness.

The Bordewijk patent, which has been cited for its purported remote control teachings, fails to remedy the battery-related deficiencies in the Faltys patent.

In view of the foregoing, applicant respectfully submits that the Final Office Action failed to establish a *prima facie* case of obviousness as to independent claim 9 and that the rejection of claims 9-13, 15 and 23 under 35 U.S.C. § 103 should be withdrawn.

With respect to claim 14, applicant respectfully submits that the Single publication, which has been cited for its purported lithium battery teachings, fails to remedy the aforementioned deficiencies in the Faltys and Bordewijk patents. Claim 14 is, therefore, patentable for at least the same reasons as independent claim 9 and the rejection of claim 14 under 35 U.S.C. § 103 should also be withdrawn.

Turning to claim 16, applicant respectfully submits that the Schulman patent, which was cited for its purported external charging circuit teaching, fails to remedy the aforementioned deficiencies in the Faltys and Bordewijk patents. Claim 16 is, therefore, patentable for at least the same reasons as independent claim 9 and the rejection of claim 16 under 35 U.S.C. § 103 should also be withdrawn.

#### **D. Discussion Concerning Claims 17-20**

Independent claim 17 is directed to a cochlear implant system that comprises “an implantable portion,” “an external portion,” “a remote control unit” and “a base station.” The **external portion** includes “a headpiece” and “a sound processor [with] sound processing circuits, an antenna coil, a **rechargeable battery integrally housed within a closed case**, and **electrical contacts embedded within or carried on an exterior surface of the closed case** that are in electrical contact with the rechargeable battery.” The respective combinations defined by claims 18-20 include, *inter alia*, the elements recited in claim 17.

The cited references fail to teach or suggest the claimed combinations. For example, the Faltys wearable unit 102 (Figure 1A) is configured such that the batteries “may be readily replaced when needed” (column 9, lines 19-21), not such that the battery is “integrally housed within a closed case.” The Faltys patent also fails to disclose the claimed “electrical contacts embedded within or carried on an exterior

surface of the closed case that are in electrical contact with the rechargeable battery.” Like the prior Office Action, the outstanding Final Office Action failed to so much as attempt to address the “electrical contacts ...” aspect of independent claim 17. In fact, the only portion of the Final Office Action which even includes the word “contact(s)” is the invitation to “contact the Electronic Business Center” on page 9.

The Bordewijk patent, which has been cited for its purported remote control teachings, fails to remedy the battery-related deficiencies in the Faltys patent.

In view of the foregoing, applicant respectfully submits that the Final Office Action failed to establish a *prima facie* case of obviousness as to independent claim 17 and that the rejection of claims 17-20 under 35 U.S.C. § 103 should be withdrawn.

#### **E. Discussion Concerning Claim 25**

Independent claim 25 is directed to an “external sound processor for use with an implantable cochlear stimulator.” The external sound processor comprises “a microphone,” “a sound processing circuit,” “a rechargeable power source permanently connected to the sound processing circuit,” “**means for** mounting the microphone, sound processing circuit and **rechargeable power source** behind a human ear” and “**means**, carried by the means for mounting, **for** transferring power from an external power source to **the rechargeable power source**.” Applicant respectfully submits that the Faltys patent fails to teach or suggest the combination defined by claim 25.

For example, the external device illustrated in Figure 1A of the Faltys patent does not include (1) structure that performs the function of “mounting [a] microphone, sound processing circuit and rechargeable power source behind a human ear” **in combination with** (2) structure, which is carried by the structure that performs the “mounting” function, that performs the function of “transferring power from an external power source to the rechargeable power source.” Nevertheless, in an attempt to read claim 25 onto something disclosed in the Faltys patent, the Final Office Action appears to have taken the position that the claimed “rechargeable power source” corresponds to the power source located within the **IMPLANTED** cochlear stimulator 112 illustrated in Figure 1A. [Final Office Action at pages 6 and 7.] This interpretation is clearly incorrect. Claim 25

calls for a “rechargeable power source” that is (1) part of the claimed external sound processor and (2) is one of the things that are mounted behind the ear by “means for mounting ...”

The Final Office Action also failed to provide any articulated reasoning and particular findings regarding modifications of the Faltys external devices that would have produced the invention defined by independent claim 25.

In view of the foregoing, applicant respectfully submits that the Final Office Action failed to establish a *prima facie* case of obviousness as to independent claim 25 and that the rejection of claim 25 under 35 U.S.C. § 103 should be withdrawn.

#### **F. Discussion Concerning Claims 21, 22 and 24**

Dependent claims 21, 22 and 24 respectively depend from independent claims 1, 9 and 17 and, accordingly, are patentable for at least the same reasons as claims 1, 9 and 17. In addition to the elements recited in independent claims 1, 9 and 17, dependent claims 21, 22 and 24 call for a case that “does not include a battery (or power source) removal door.” Here, the Final Office Action asserted that:

[T]he arguments presented by the examiner as pertaining to the ISP are equally applicable to the external sound processor processor: Faltys' system makes no mention of a power source removal door, and furthermore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a sound processor case that does not include a power source removal door, since such a door would be unnecessary for a battery that is not to be removed from the sound processor.

[Office Action at page 7.] There are a variety of errors associated with this assertion. Most notably, nothing in the Faltys patent even remotely suggests that the batteries associated with the wearable unit 102 (or BTE unit 120) are “not to be removed.”

Additionally, the presence or absence of a battery removal door on an **IMPLANTED** signal processor (“ISP”) that is located within the wearer’s skull, and is specifically configured to be re-charged by a device that is located outside the skull, is entirely unrelated to an external speech processor. Applicant respectfully submits, for example, that one of skill in the art would readily recognize that a battery removal door is not especially useful on ISP that (1) has to be surgically removed from the patient’s skull in

order to gain access to thereto and (2) is configured to recharge the battery itself when it is inductively coupled to a device (i.e. the external unit illustrated in Figure 1C) that is located outside the skull. These considerations have nothing whatsoever to do with an external unit.

Accordingly, for reasons in addition to those presented above with respect to independent claims 1, 9 and 17, applicant respectfully submits that the Final Office Action failed to establish a *prima facie* case of obviousness of the inventions defined by dependent claims 21, 22 and 24 and that the rejection thereof under 35 U.S.C. § 103 should be withdrawn.

#### IV. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

August 28, 2007  
Date

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## **EXHIBIT 1**

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN R. SCHOESSOW

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Appeal No. 96-0079  
Application No. 08/114,391<sup>1</sup>

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ON BRIEF

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Before LYDDANE, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1, 4 and 5. Subsequent to the final rejection, claims 2 through 4 were amended, resulting in the allowance of claims 2 and 3, the withdrawal of the 35 U.S.C. § 112, second paragraph,

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<sup>1</sup> Application for patent filed August 31, 1993.

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rejection of claims 4 through 6 and the objection to claim 6 as depending from a rejected claim.

We REVERSE.

#### BACKGROUND

The appellant's invention relates to a livestock feeding structure. Claims 1 and 4 are representative of the subject matter on appeal and a copy of claims 1 and 4 is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Schoessow	4,258,663	Mar. 31, 1981
Harton	4,930,449	June 5, 1990

Claims 1, 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Harton in view of Schoessow.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 rejection, we make reference to the examiner's answer (Paper No. 12, mailed



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June 27, 1995) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 11, filed May 5, 1995) for the appellant's arguments thereagainst.

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### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Before addressing the examiner's rejection based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988).

The general rule is that terms in claims are to be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently. See Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir.

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1984) and Hoechst Celanese Corp. v. BP Chems. Ltd., 78 F.3d 1575, 1578, 38 USPQ2d 1126, 1129 (Fed. Cir. 1996). Furthermore, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

In this case we find it necessary to construe the meaning of the terminology "permanently affixed" as recited in claim 1 with regard to the mounting of the feed hopper in the livestock feeding structure. In the background of the invention (specification, p. 1), the appellant describes the livestock feeder wagon of his prior patent (Schoessow 4,258,663) as including removable panels which can be secured to an inner framework to provide a feed bunker. In the summary of the invention (specification, p. 1), the appellant states that his livestock feeding bunker in the present invention is constructed with permanently mounted panels carried on a framework grating to form a hopper. In the description of the invention (specification, p. 4), the appellant explains that plates 16 form

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a feed hopper and that the plates 16 are preferably rigidly welded in place. The American Heritage Dictionary, Second College Edition (1982), defines "permanent" as "Fixed and changeless; lasting or meant to last indefinitely."

Our review of the specification, as originally filed, and the dictionary definition leads us to conclude that one of ordinary skill in the art would understand the terminology "permanently affixed" as recited in claim 1 to mean that the hopper is nonremovably affixed (such as by welding) in the livestock feeding structure.

Additionally, we find it necessary to construe the terminology "one side of the structure" recited in claims 1 and 4. In the description of the invention (specification, p. 3), the appellant explains that gates, such as gate 12 in Figures 1 and 2, may be provided along one or both sides of the wagon. Thus, the appellant's specification clearly distinguishes the sides of the wagon 10 from the ends of the wagon (i.e., end frames 15 and 26 seen in Figures 1 and 2). Our review of the specification, as originally filed, thus leads us to conclude that one of ordinary skill in the art would understand that the

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terminology "one side of the structure" as recited in claims 1 and 4 refers to the long sides of the wagon (structure), not the short ends of the wagon (structure).

Next, we turn to the issue of whether the limitations in claims 1 and 4 relative to the size of the "openings" are entitled to be given weight. We agree with the appellant's argument (brief, pp. 8-11) that the examiner inappropriately ignored the limitations in claims 1 and 4 relative to the size of the "openings." The limitations in claims 1 and 4 relative to the size of the "openings" limit the size of the "openings" in the structure being claimed and therefore must be given weight. See In re Stencil, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

Having interpreted the claims on appeal in the manner explained above, we find ourselves in agreement with the appellant that the claimed invention would not have been obvious to one of ordinary skill in the art at the time of the appellant's invention based on the combined teachings of Harton and Schoessow. While we agree with the examiner that it would have been obvious to provide the feeder of Harton with a

hopper/bin in view of Schoessow, we do not see that the applied prior art suggests a feed hopper that is permanently affixed in the livestock feeding structure, or wherein at least a portion of one side of the feed hopper is permanently affixed to the hinged portion of one upright framework side so as to rotate therewith, as required in claim 1 on appeal. In our opinion, a combination of the applied prior art would have provided a removable hopper/bin in the feeder of Harton, not a hopper/bin that is permanently affixed in the feeder of Harton. Since all the limitations of claim 1 are not met or rendered obvious by the prior art applied by the examiner, we will not sustain the 35 U.S.C. § 103 rejection of claim 1.

We agree with the appellant's argument (brief, p. 7) regarding claim 4 that Harton's feeder, even when modified by Schoessow in the manner set forth by the examiner, does not provide unobstructed access into the structure above the level of the floor. In that regard, we note that Harton's crossbar 9, reinforcing structure 4 and roof 3 would obstruct access into the feeder above the level of the floor 7 as shown in Figures 1 and 2. Since all the limitations of claim 4 are not met by the prior art applied by the examiner, we will not sustain the 35 U.S.C.

Appeal No. 96-0079  
Application No. 08/114,391

§ 103 rejection of claim 4 and its dependent claim 5.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 4 and 5 under 35 U.S.C. § 103 is reversed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

WILLIAM E. LYDDANE	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

Appeal No. 96-0079  
Application No. 08/114,391

KEITH SCHOFF  
2257 EAST WASHINGTON AVENUE  
MADISON, WI 53704



APPENDIX

1. In a livestock feeding structure embodying a floor and at least one upright framework side provided with openings for livestock to reach with their heads and necks into the structure for the purpose of feeding, an improvement comprising:

a) at least a portion of at least one upright framework side being hinged to rotate about a substantially vertical axis for providing unobstructed access into said structure through at least a portion of one side of said structure above the level of said floor to facilitate loading large round bales into said structure in side by side disposition,

b) a feed hopper having an open bottom elevated above said floor wherein said hopper is permanently affixed in said structure with at least a portion of one side of said hopper being carried by said portion of at least one upright framework side.

4. A livestock feeding structure which is universally applicable for dispersing substantially all forms of solid feed, including large round bales and fine feed, said structure comprising:

a) a manger configured floor,

b) a framework rising, substantially vertically from the peripheral portion of the floor, wherein at least a portion of said framework is provided with openings for livestock to

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reach with their heads and necks into the structure for the purpose of feeding,

c) a feed hopper carried on said framework above said floor, said feed hopper being configured with side plates with a smaller opening dimension at the bottom of said plates than at the top thereof, a lesser dimension of said opening between said plates at the bottom of said hopper being sufficient to receive therein a hay bale,

d) at least one portion of said framework on at least one side of said structure being hinged about a substantially vertical axis at one end to swing open carrying one said side plate of said hopper attached thereto to provide at least a portion of said side of said structure unobstructed above the level of said floor to facilitate loading of bales into said structure from said side,

e) latch means for securing said at least one portion of said framework.

APPEAL NO. 96-0079 - JUDGE NASE  
APPLICATION NO. 08/114,391

APJ NASE

APJ FRANKFORT

APJ LYDDANE

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

**DRAFT TYPED:** 23 Sep 97  
1st Rev. 01 Oct 97

**FINAL TYPED:**

## **EXHIBIT 2**

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARTEN BURGDORF  
and DIETMAR PRZYTULLA

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Appeal No. 97-2535  
Application 08/129,108<sup>1</sup>

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HEARD: APRIL 7, 1999

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Before McCANDLISH, Senior Administrative Patent Judge, COHEN and MEISTER, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 9, 10 and 14 through 24. The only other claims still pending in the application have been withdrawn from consideration as being directed to a non-elected invention.

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<sup>1</sup> Application for patent filed November 18, 1993. According to appellants, this application is a 371 of PCT/EP93/00284, filed February 6, 1993.

Appellants' invention relates to a pallet container assembly (10) having a plastic container (12), a steel mesh support cage (14) and a floor pallet (16). The plastic container (12) is seated on what is described as a top plate (22)<sup>2</sup> of the floor pallet. The steel mesh support cage (14) peripherally surrounds the plastic container (12) and is described as having horizontal rods (34) and vertical rods (18) welded to the horizontal rods. The lowermost horizontal rod (34) of the cage (14) is seated on the upper face of the top plate (22) of the floor pallet. The floor pallet also includes a bottom plate (24) and a structure between the top and bottom plates

In the embodiment shown in Figure 3 of appellants' drawings, some of the vertical rods (18) are longer than others. These longer vertical rods extend through bores (20) in the pallet plates and are threaded at their lower ends (26) to removably receive nuts (28). The nuts (28) engage the underside of the bottom pallet plate (24) to effectively connect the threaded vertical rods (18) to the bottom pallet plate (24), thereby securing the plastic container (12) in place on the top pallet plate (22). In other embodiments, such as Figure 5, discs (30) engage the underside of the bottom pallet plate and are welded to the lower ends of the longer vertical rods (18) to effectively provide a permanent attachment of the longer vertical rods to the bottom pallet plate.

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<sup>2</sup> The top plate of the floor pallet is shown in Figure 3 to constitute two plate members, one seated on the other.

An amendment directed to claim 18 and filed with appellants' reply brief has been entered by the examiner (see the supplemental answer mailed January 29, 1997). A copy of claim 18 in its amended form, along with the other appealed claims, is appended to appellants' reply brief (Paper No. 24). Because of the multiple dependency of claims 14, 15, 17 and 18, the copy of the claims appended to appellants' reply brief, as well as appellants' main brief, include claims that were withdrawn by the examiner as being direct to a non-elected invention. To set the record straight, the claims on appeal are claims 9, 10, 14/9, 14/10, 15/14/9, 15/14/10, 16, 17/9, 17/10, 18/9, 18/10 and 19 through 24.

A copy of claim 9, which is illustrative of the subject matter at issue, is appended to this decision.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Marques	4,054,223	Oct. 18, 1977
Schutz	4,909,387	Mar. 20, 1990
Rudko	4,921,196	May 1, 1990
Salaun et al. (Salaun) (France Application) <sup>3</sup>	2,643,043	Aug. 17, 1990

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<sup>3</sup> Translation attached.

The grounds of rejection are as follows:

1. Claims 9, 10, 17/9, 17/10, 18/9 and 18/10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schutz in view of Rudko and Marques.

2. Claims 14/9, 14/10, 15/14/9 and 15/14/10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the references applied in the rejection of claims 9 and 10 above, and further in view of Salaun.

3. Claims 9, 10 and 14 through 24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regards as their invention.<sup>4</sup>

With regard to the rejection of the appealed claims under the second paragraph of § 112, the examiner states that the independent claims, namely claims 9, 16 and 19, "are indefinite because they are submitted in improper Jepson type format" (answer, page 4). His position is

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<sup>4</sup> We will decide this rejection on basis of the claims that are actually on appeal as we have set forth above.



that the recitation of the word "wherein" instead of the word "comprises" in the preambular phrase "the improvement wherein . . ." renders the claim language indefinite.

Admittedly, the word "comprises" is used in the customary Jepson format. Although this language is suggested in 37 CFR § 1.75(e), it does not necessarily follow that the use of the word "wherein" in place of the word "comprises" renders the claims indefinite. Despite the use of the word "wherein" in the preambular phrase "the improvement wherein . . .", one skilled in the art would nevertheless understand what is claimed. As a result, the claims are considered to be definite as required by the second paragraph of § 112. See Seattle Box Co. v. Industrial Crating & Packing Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). Accordingly, we must reverse the examiner's rejection of claims 9, 10 and 14 through 24 under the second paragraph of § 112.

With regard to the § 103 rejection of independent claim 9, the examiner concludes that "[i]t would have made it obvious to replace the welded vertical rod connection [of Schutz] with a threaded connection by adding threads to the vertical rod of Schutz and extending this vertical rod through the plate of Schutz and fastening the vertical rod to the plate with a nut as taught by both Marques and Rudko in order to make the connection between the vertical rod and pallet

detachable to provide for [the] replacement of damaged parts without having to replace the entire pallet container" (answer, page 7). This rejection is not sustainable.

It is well established patent law that there must be some teaching, suggestion or inference in the prior art as a whole or some knowledge generally available to one of ordinary skill in the art that would have led one of ordinary skill in the art to make the modification needed to arrive at the claimed invention. See, inter alia, In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed Cir. 1988) and Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988). See also In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) (the prior art must provide one of ordinary skill in the art with the motivation to make the modification needed to arrive at the claimed invention).

In the present case, appealed claim 9 expressly requires that the mesh cage be permanently attached to the floor plate. In contrast, both Marques and Rudko suggest the concept of detachably connecting vertical rods to a floor plate. Thus, even if the teachings of Marques and Rudko would have made it obvious to detachably connect the vertical rods of Schutz's cage to the floor plate for purpose stated by the examiner, the result would not arrive at

Appeal No. 97-2535  
Application 08/129,108

the invention defined in claim 9 as required in Fine, 837 F.2d at 1074, 5 USPQ2d at 1598.

Accordingly, we must reverse the § 103 rejections of appealed claims 9, 10, 14/9, 14/10, 15/14/9, 15/14/10, 17/9, 17/10, 18/9 and 18/10.

Under the provisions of 37 CFR § 1.196(b), the following new grounds of rejection are entered against claims 9, 10 and 14 through 24:

1. Claims 9, 10, 14/9, 14/10, 15/14/9, 15/14/10, 16, 17/9, 17/10, 18/9, 18/10 and 19 through 24 are rejected under the first paragraph of 35 U.S.C. § 112 as being based on a specification which, as filed, does not satisfy the description requirement in that paragraph.

2. Claims 10, 14/10, 15/14/10, 17/10, 18/10, and 19 through 24 are rejected under 35 U.S.C. § 112 ¶ 2 as being indefinite and hence failing to particularly point out and distinctly claim the subject matter which appellants regards as their invention.

Considering first the new rejection under the first paragraph of § 112, all of the independent claims 9, 16 and 19 recite that the mesh cage is permanently attached to the same plate on which the

plastic container is seated. However, according to appellants' application disclosure as filed (namely the original specification, the original claims and the original drawings), the plastic container is seated on the top plate of the pallet floor while the mesh cage is attached to the bottom plate of the pallet floor though the engagement of the fastening elements (e.g., discs 30) with the underside of the bottom plate. The specific language that the container and the cage are respectively seated on and permanently attached to the same floor plate cannot be ignored.

As a result, the disclosure in appellants' application as originally filed does not reasonably convey to the artisan that appellants had possession at that time of the subject matter now claimed. The disclosure as originally filed, therefore, does not satisfy the description requirement in the first paragraph of § 112. See In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

With regard to the new rejection under the second paragraph of § 112, the combination defined by dependent claim 10 contains limitations of two mutually exclusive embodiments, namely the embodiment of Figure 5 (and its variation in Figure 6) and the embodiment of Figure 3. In the embodiment of Figure 5, the cage is permanently attached to the pallet floor plate. In the embodiment of Figure 3, the cage is detachably connected to the floor plate by the removable nuts 28.

Parent claim 9 recites that the cage is permanently attached to the pallet floor plate and thus is readable on the embodiment of Figure 5 to the exclusion of the embodiment of Figure 3. Claim 10, on the other hand, recites the threaded nut (28) and therefore is readable on the embodiment of Figure 3 to the exclusion of the embodiment of Figure 5. In substance, the combination of claim 10 contains two mutually exclusive limitations, namely the permanent attachment of the cage, on the one hand, and the detachable nut attachment, on the other hand. Thus, the metes and bounds of claim 10 are obscured because it requires reading on two mutually exclusive embodiments.

Similar to the combination of claim 10, claim 19 recites the permanent attachment of the cage to the floor plate and detachable threaded nut connection in the same combination. Recitation of these mutually exclusive limitations in the same combination obscures the metes and bound of claim 19 and also of claims 20 through 24 which depend directly or indirectly from claim 19.

In summary, the examiner's decision rejecting claims 9, 10 and 14 through 24 is reversed, and new grounds of rejections have been entered against claims 9, 10, 14/9, 14/10, 15/14/9, 15/14/10, 16, 17/19, 17/10, 18/9, 18/10 and 19 through 24 under the provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended

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effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

REVERSED/196(b)

Appeal No. 97-2535  
Application 08/129,108

HARRISON E. McCANDLISH	)	
Senior Administrative Patent Judge	)	
	)	
	)	
	)	
IRWIN CHARLES COHEN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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	)	
JAMES M. MEISTER	)	
Administrative Patent Judge	)	

HEM/dal

Appeal No. 97-2535  
Application 08/129,108

PENNIE & EDMONDS  
1667 K ST., N.W.  
WASHINGTON, D.C. 20006



## **APPENDIX**

9. In a pallet container (10) comprised of a thin-walled plastic container (12) for liquid or flowable substances, a steel-mesh support cage (14) of horizontal and vertical rods welded together and tightly enclosing the plastic container (12), and a floor pallet (16) including at least one plate having a bottom side and an opposite top side on which the plastic container (12) is seated and to which the steel-mesh support cage is permanently attached, the improvement wherein:

a) the pallet includes at least one bore (20) extending into said at least one plate from the top side thereof; and

b) one vertical rod (18) of said vertical rods of the steel-mesh support cage (14) extends into each bore (20) from the top side of said at least one plate and is connected to said plate against relative movement with respect thereto.

## **EXHIBIT 3**

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte HANS-PETER WILFER

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Appeal No. 2004-0603  
Application No. 09/713,353

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ON BRIEF

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Before ABRAMS, NASE and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 12 and 14-22, which are all of the claims pending in this application. Claims 12, 15 and 17 were amended subsequent to the final rejection (see Paper Nos. 10 and 11) and claim 13 was canceled.

We AFFIRM-IN-PART.

### BACKGROUND

The appellant's invention relates to a case for musical instruments comprising a shell, a device for carrying the case and attachable to the shell, such as shoulder belts and handles, and an element for receiving a communication device provided on the device for carrying the case (specification, pages 1 and 2). Representative claims 12 and 19 are reproduced, infra, in the opinion section of this decision.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Ekman et al. (Ekman)	4,764,962	Aug. 16, 1988
Gormley et al. (Gormley)	5,711,469	Jan. 27, 1998
Fowles et al. (Fowles)	6,123,240	Sep. 26, 2000 (filed Oct. 20, 1998)
Fiedler	EP 756,266	Jul. 30, 1997
Miyako et al. (Miyako) (Japanese patent publication)	9-154618	Jun. 17, 1997 <sup>1</sup>

The following rejections are before us for review.

Claims 12, 14, 15<sup>2</sup> and 17-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fiedler in view of Miyako and Ekman.

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<sup>1</sup> We derive our understanding of the Fiedler and Miyako references from the translations, provided by the USPTO, copies of which have been mailed to appellant (see page 3 of the answer, Paper No. 15). The Miyako reference was referred to by the examiner and appellant as "Nobuhide."

<sup>2</sup> Claim 15 had been rejected in the final rejection (Paper No. 9) as being unpatentable over Fiedler in view of Miyako, Ekman and Richards (U.S. Pat. No. 4,237,341). In light of the amendment (Paper No. 10) filed subsequent to the final rejection, the rejection has been changed to reflect the amendment to claim 15.

Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Fiedler in view of Miyako, Ekman and Fowles.

Claim 22 stands rejected under 35 U.S.C. § 103 as being unpatentable over Fiedler in view of Miyako, Ekman and Gormley.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 20) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 14 and 16) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn our attention first to claim 19, which reads as follows:

19. A case for musical instruments, comprising a shell;  
means for carrying the case and attached to the shell; and  
means provided on the carrying means for receiving a  
communication device, wherein the receiving means  
comprises a closable pocket having an insertion opening.

Fiedler discloses a box 1 for holding a musical instrument and straps 3, 4 connected via a hook buckle 20 with straps 10, 11 worn by the person carrying the box

as illustrated in Figure 1. As best seen in Figures 1 and 2, the upper ends of straps 3, 4 are attached to the box at an upper portion thereof, the upper ends of straps 10, 11 are attached to the box at an intermediate portion thereof and the lower ends of straps 3, 4 are attached to a lower portion of the box, with the hook buckle 20 resting on the person's shoulder so that it may take up a shoulder bag (see Figure 1 and page 11 of the translation). The examiner concedes that Fiedler lacks "means provided on the carrying means for receiving a communication device, wherein the receiving means comprises a closable pocket having an insertion opening," as called for in claim 19.

Miyako discloses a carrying case for a mobile telephone or the like designed for attachment either to a belt (Figures 1 and 6) worn on slacks or to a "backpack or other shoulder applying belt" (translation, page 8), as illustrated in Figures 5(C) and 7. The carrying case has an upper opening which is closable by a narrow covering piece 2, with openings on either side thereof for passage of, for example, an antenna (translation, page 15).

Miyako, with its teaching of attaching a carrying case for a mobile telephone, cassette tape recorder, camera, binoculars or the like (translation, page 10) to the shoulder straps of, for example, a backpack, would have provided ample motivation to one of ordinary skill in the art at the time of appellant's invention to attach such a carrying case to one of the straps 3, 4, 9, 10 of Fiedler's musical instrument holding box to attain the self-evident advantage of convenience in carrying the mobile telephone or

the like device, thereby arriving at the subject matter of claim 19, either with or without the additional teachings of Ekman.

Ekman further evidences that it was well known at the time of appellant's invention to attach a pouch 18, with a cover 18b, to shoulder straps for storage of a Walkman-type radio or cassette recorder. Thus, in view of the combined teachings of Fiedler, Miyako and Ekman, it would have been obvious to one of ordinary skill in the art to provide on one of the shoulder straps 3, 4, 9, 10 of Fiedler, a carrying case or pouch of the type taught by Miyako or Ekman to store a mobile telephone, cassette recorder or the like device conveniently to arrive at appellant's invention as recited in claim 19.

Appellant argues on page 11 of the brief that none of Fiedler, Miyako and Ekman "discloses or suggests providing a closable pocket on carrying means for a case for musical instruments or any other case for that matter." We do not find this argument persuasive. First, Miyako does disclose providing a closable pocket on the shoulder strap of a backpack, which is, in our opinion, a case. Moreover, nonobviousness cannot be established by attacking the references individually when, as in the instant case, the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

For the foregoing reasons, we conclude that the combined teachings of Fiedler, Miyako and Ekman are sufficient to have suggested the subject matter of claim 19.

Thus, we shall sustain the rejection of claim 19, as well as dependent claims 20 and 21 which appellant has grouped with claim 19 (brief, page 5), as being unpatentable over Fiedler in view of Miyako and Ekman.<sup>3</sup> We shall also sustain the rejection of dependent claim 22 as being unpatentable over Fiedler in view of Miyako, Ekman and Gormley since the appellant has not challenged such with any reasonable specificity (See In re Nielson, 816 F.2d 1567, 1572, 2USPQ2d 1525, 1528 (Fed. Cir. 1987)) and in fact has indicated that claim 22 stands or falls with claim 19 (brief, page 5).

We turn our attention next to independent claim 12, which reads as follows:

12. A case for musical instruments, comprising a shell;  
means for carrying the case and attached to the shell; and  
means permanently attached to the carrying means for  
receiving a communication device,  
[w]herein the carrying means comprises two shoulder  
belts, and wherein the receiving means is permanently  
attached to one of the shoulder belts on an outer side of the  
one of the shoulder belts.

None of the references, Fiedler, Miyako and Ekman, relied upon by the examiner in rejecting claim 12 teaches or suggests a permanent attachment of a receiving means to a shoulder belt. We find no such teaching, in particular, in Ekman, the reference alluded to by the examiner on page 4 of the answer as teaching a permanent attachment of a means for receiving an audio device to a carrying means. While

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<sup>3</sup> See 37 CFR § 1.192(c)(7) and In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).



Ekman discloses securement of the pouch 18 to strips 30 by stitching,<sup>4</sup> the straps 22, 24, which correspond to the claimed “carrying means”, are simply placed within loops defined by the strips 30 and thus are not permanently secured thereto. See the last paragraph of column 2 of Ekman. Accordingly, the pouch 18 cannot reasonably be considered to be permanently attached to the straps 22, 24.

In light of the foregoing, the combined teachings of Fiedler, Miyako and Ekman would not have suggested permanent attachment of a receiving means to one of the shoulder belts of Fiedler’s device to arrive at the subject matter of claim 12. It thus follows that we cannot sustain the rejection of claim 12, or claims 14, 15, 17 and 18 which depend therefrom, as being unpatentable over Fiedler in view of Miyako and Ekman. Inasmuch as Fowles, relied upon by the examiner for its teaching of a protection foil (electromagnetic shield 54) in a pouch for a communication device (pager), likewise fails to teach that which is lacking in the combination of Fiedler, Miyako and Ekman, we also cannot sustain the rejection of dependent claim 16 as being unpatentable over Fiedler in view of Miyako, Ekman and Fowles.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 12 and 14-22 under 35 U.S.C. § 103 is affirmed as to claims 19-22 and reversed as to claims 12 and 14-18.

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<sup>4</sup> The examiner’s characterization of such an attachment as permanent is certainly reasonable, especially in light of appellant’s disclosure on page 7, in lines 4 and 5, of the present specification.

No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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JDB/vsh

Appeal No. 2004-0603  
Application No. 09/713,353

Page 9

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